



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,889	04/14/2004	Toby Wexler	20040414	7321
31346	7590	01/03/2006	EXAMINER	
ROBERT N. MONTGOMERY 109 BROWNLEE AVE. BROUSSARD, LA 70518-3021			SMITH, KIMBERLY S	
			ART UNIT	PAPER NUMBER
			3644	
DATE MAILED: 01/03/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/824,889

Applicant(s)

WEXLER, TOBY

Examiner

Kimberly S. Smith

Art Unit

3644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7, 11, 14-17 and 27-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11, 14-17 and 27-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 November 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 11/02/05 have been fully considered but they are not persuasive. As an initial point, the applicant has stated that the examiner has acknowledged that claims 1-7, 11 and 14-17 are directed to allowable subject matter, however no such statement has been made as is evident by the rejection of record.
2. In response to applicant's argument that Field discloses a finger cot which is not an article shape consistent with that of an animal toenail, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The Applicant has stated that animal toenails are curved and pointed unlike that of a human finger. However, it is noted that the limitation is regarding a shape consistent with that of an animal toenail is not limited or positively claimed to that having a curved and pointed nail. As such, it is maintained that the Field reference may in fact be fitted to the nail of an animal such as a grizzly bear whose toenail is consistent with the article shape disclosed by Field.
3. With respect to the argument that Field is detachably mounted within a recessed notch and not adhered as suggested by the examiner. It is maintained that per the Applicant's own statement regarding Field being "detachably mounted" inherently implies that the appliqué is in fact adhered. As is clearly seen from the figures, the appliqué is a second, separate layer and thereby meets the claimed limitation of a second layer.

Art Unit: 3644

4. Regarding the argument that the Field disclosure does not teach an animal toenail covering that encompasses at least a portion of the toenail covering. As is clearly seen in the figures, the false fingernail does in fact encompass at least a portion of the toenail covering (i.e. the area over which the nail lies).

5. Regarding the argument with respect to rigidity. While the applicant is correct in stating that the hardness of the material may be due to the structural thickness of the material, it is clearly stated that the sheath is slightly pliable plastic and the fingernail insert is formed of a rigid plastic. As Figure 3 clearly shows, it is the fingernail insert which is of a thinner structural thickness and thereby, along with the positive statement that the fingernail insert is a rigid material, it is therefore maintained that Field discloses the second layer of polymer is harder than that of the polymeric sheath.

6. With respect to the argument regarding the term "delamination": Merriam-Webster's Collegiate Dictionary Tenth Edition defines *delamination* as a separation into constituent layers. As Field clearly discloses two constituent layers as seen in Figure 3, Field discloses providing the sheath with a delamination between the sheath and the second layer.

7. Regarding the Applicant's arguments with respect to the adhesive element. The Applicant is correct in stating that there are indeed a number of ways to attach a false fingernail such as grooves or dimples, however, these are clearly not shown in the figures and are therefore not disclosed by Fields. Further, given the manner in which the device is to be used, a vacuum adhesion would not be a functional method of attaching the structure as the finger cot inherently is designed to move with a finger and would thereby remove any vacuum adhesion during use.

Art Unit: 3644

As such, it is maintained that the use of an adhesive element would be obvious to one with skill in the art.

*Drawings*

8. The drawings were received on 11/02/05. These drawings are accepted.

*Claim Objections*

9. Claim 28 recites the limitation "said covering" in line 2. There is insufficient antecedent basis for this limitation in the claim.

*Claim Rejections - 35 USC § 112*

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 32-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Applicant has claimed that the sheath defines a telescopic relationship over the animal toenail. However, as the sheath is a singular fixed apparatus, it is unclear as to how the sheath is capable of having a telescopic relationship over the animal's toe nail. Further regarding

Art Unit: 3644

claim 38, the specification as initially filed does not provide a basis for a limitation in which the sheath has an rectangular opening to an interior cavity.

12. Claims 32-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Applicant has claimed that the sheath defines a telescopic relationship over the animal toenail. However, as the sheath is a singular fixed apparatus, it is unclear as to how the sheath is capable of having a telescopic relationship over the animal's toe nail.

13. Claim 34 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a singular sub layer, does not reasonably provide enablement for any sub-layer. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to reproduce the invention commensurate in scope with these claims. The specification provides an enabling disclosure for a singular sheath having an external coating applied thereto. However, the specification does not provide an enabling disclosure for there to be more layers than the singular sheath and the singular external coating.

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claims 1-7, 11, 14-17, 31, 37 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3644

16. Claim 1 recites the limitation "said polymeric sheath" in lines 6 and 5. There is insufficient antecedent basis for this limitation in the claim.

17. Regarding claims 4, 31 and 37, where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "anticline" is used by the claim to mean "cleats directed towards a central point", while the accepted meaning is "a fold with strata sloping downward on both sides from a common crest." The term is indefinite because the specification does not clearly address or define the term.

18. Claims 32-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 32 states that the pliable sheath is used for telescopically encasing an animal toenail. However, it is unclear as to what is meant by telescopically? The specification is silent as to the terminology "telescopically"

### ***Claim Rejections - 35 USC § 102***

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3644

20. Claims 1, 2, 5, 27, 28, 30, 32-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Field, US Patent 4,908,881.

Field discloses a polymeric sheath (44) having an opening (46) and an internal and external shape generally consistent with that of an animal's toenail, the polymeric sheath comprising a second layer of polymer (48) encompassing at least a portion of the polymeric sheath (reference Figure 3).

Regarding Claims 2, 28 and 34, Field discloses the second layer of polymer is harder than that of the polymeric sheath (column 3, line 17 and column 3, lines 27-30).

Regarding claim 5, Field discloses that the second layer may be removable from the sheath thereby providing the sheath with the delamination between the sheath and the second layer of polymer (reference discussion above in Response to Arguments).

Regarding claim 30, Field discloses the coating is applied to the sheath. It has been held that the functional "whereby" statement does not define any structure and accordingly cannot serve to distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957).

Regarding claims 32 and 33, Field discloses the covering having a non-uniform wall thickness having a greater thickness at the distal end than at the proximate end (as viewed in Figure 3) wherein the non-uniform wall thickness is a lamination of layers.

Regarding claim 35, Field discloses a void (50) located between the layers.

### ***Claim Rejections - 35 USC § 103***

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:



Art Unit: 3644

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claims 3, 6, 7, 14-17, 29, 36 and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Field, US Patent 4,908,881.

Regarding claims 3, 29 and 36, Field discloses the invention as claimed. However, Field does not positively disclose that the second layer of polymer is a different color than the polymeric sheath. Field does disclose that the second layer may be prepared in various colors and designs for aesthetic purposes. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a sheath of differing color than the second polymer layer so as to provide more contrast and thereby add to the aesthetic nature of the device.

Regarding claim 6, Field discloses that the second polymer layer is mounted to the sheath. While not positively stating that an adhesive element is used, it would have been obvious to one having ordinary skill in the art that such an adhesive element must be present as there is no structural mechanism in which to retain the second polymer layer onto the sheath.

Regarding claims 7, 14 and 15, while Field suggests the use of an adhesive, the type of adhesive to be used is not disclosed. However, it is evident from the structure that the adhesive to provide the mounting of (48) at (50) must be located between the polymeric sheath and the second layer of polymer. One of skill in the art would consider the use of a liquid adhesive, a powered adhesive or an aerosol adhesive as a matter of obvious routine choice of design rather than constitute a patentably distinct inventive step barring a convincing showing of evidence to the contrary.

Art Unit: 3644

Regarding claims 16 and 17, the process of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight. These are product-by-process claims.

Regarding claim 38, Field discloses the invention substantially as claimed. However, Field does not disclose the opening into the cavity to be rectangular. It would have been an obvious matter of design choice to use any shaped opening consistent with the appendage on which the device is to be placed, since applicant has not disclosed that the rectangular opening solves any stated problem or is for any particular purpose (as the shape has not been discussed within the specification) and it appears that the invention would perform equally well with any shaped opening so as to be snugly fit on the appendage of the wearer.

Regarding claim 39, Field discloses the overlay is a different material composition than the sheath.

23. Claims 4, 11, 31 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Field as applied to claim 1 above, and further in view of Johns, US Patent 2,285,981.

Regarding claims 4, 31 and 37 as best understood, Field discloses the invention substantially as claimed. However, Field does not disclose the use of internal cleats. Johns teaches within the same field of endeavor the use of internal cleats (7) for preventing the sheath from slipping off. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the cleats as taught by Johns with the device of Field in order to maintain the sheath in the correct position.

Art Unit: 3644

Regarding claim 11, Fields as modified per the discussion above provides for a textured inner wall surface.

### ***Conclusion***

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly S. Smith whose telephone number is 571-272-6909. The examiner can normally be reached on Monday thru Friday 10:00-4:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on 571-272-7045. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3644

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

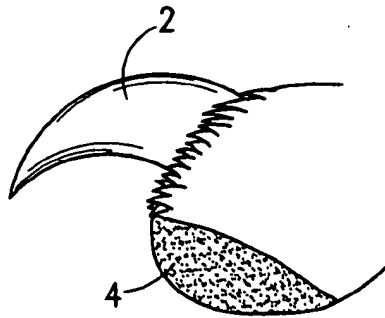
Kimberly S Smith  
Examiner  
Art Unit 3644

kss

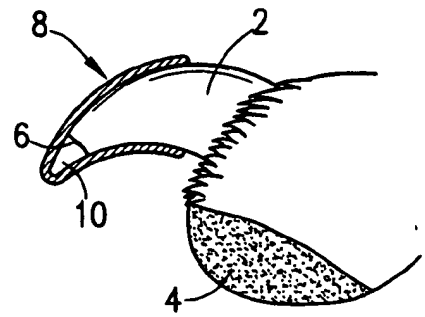


TERI PHAM LUU  
SUPERVISORY  
PRIMARY EXAMINER

+

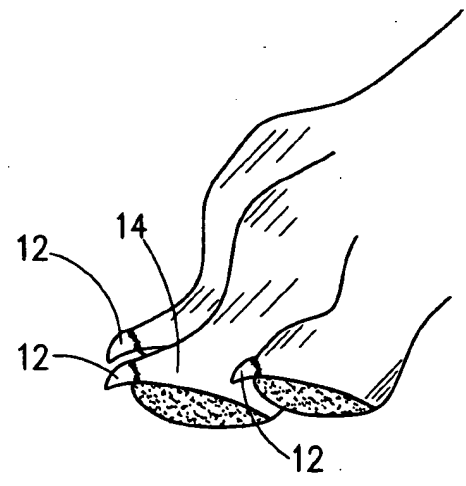


**Fig. 1**



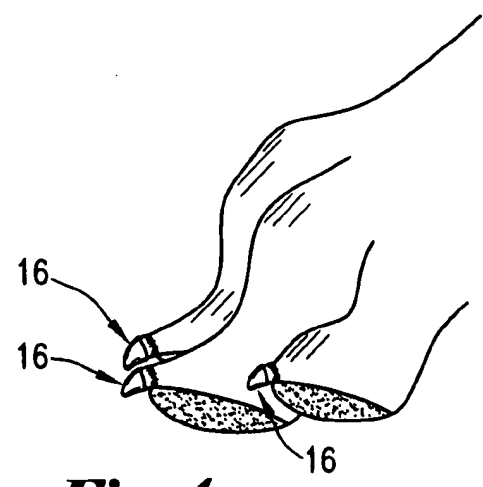
**Fig. 2**

PRIOR ART



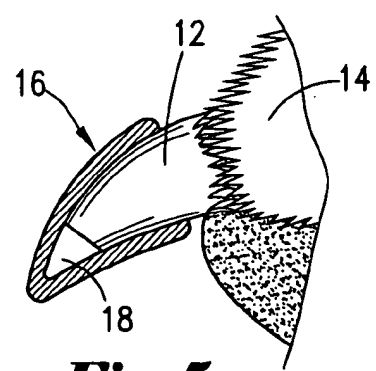
**Fig. 3**

PRIOR ART



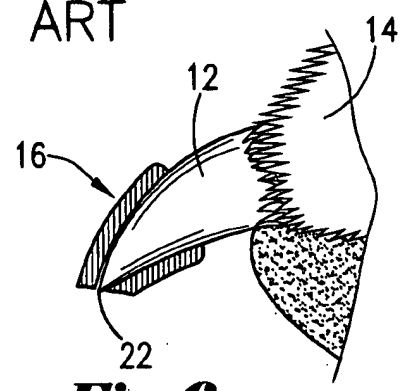
**Fig. 4**

PRIOR ART



**Fig. 5**

PRIOR ART



**Fig. 6**

PRIOR ART

+

OK to enter 12/27/05 kg